Remarks

In view of the above amendments and the following remarks, favorable reconsideration of the outstanding Office Action is respectfully requested.

1. Drawings

The Examiner has indicated in the accompanying form PTO-948 that the informal drawings previously submitted have not been approved. Applicant has submitted a set of formal drawings to overcome the Examiner's objections.

2. Allowed Claims/Subject Matter

Applicant notes with appreciation that the Examiner has indicated the subject matter of claims 4, 8, 10, 11, 14 and 19 would be allowable if rewritten in independent form, including all of the limitations of the base claim and intervening claims. However, in light of the arguments made below in support of the allowability of claim 16, from which each of the above claims depends either directly or indirectly, Applicant has elected to defer amendment of these claims until the final disposition of claim 16 has been determined.

3. § 102 Rejections

The Examiner has rejected claims 16, 2, 3, 5, 6, 7, 9, 12, 13, 17, 18, 41 and 42 under 35 U.S.C. § 102(e) as being anticipated by Wang, U.S. Patent No. 6,373,620 A ("Wang"). Applicant respectfully submits that the Examiner has improperly applied Wang et al to the present invention.

The Examiner clearly acknowledges at the top of page 3 of the Office Action, in connection with the rejection of claim 16, that "Wang does not implicitly discloses (sic) that an array of pixel circuits formed with the semiconductor substrate, each pixel being connected to a pixel circuit." But the Examiner goes on to say that "it is inherent from Wang's structure since an array of pixels will not operate without an array of pixel circuits." First of all, Applicant wishes to point out the logical inconsistency between the Examiner's statement that Wang does not *implicitly* disclose the array of pixel circuits with the semiconductor substrate and the subsequent statement that such an array of pixel circuits is *inherent*. According to The American Heritage Dictionary of the English Language, School

Edition, 1975, the word "implicit" is defined as "inherent or contained in the nature of something although not directly expressed."

In a recent decision by the Court of Appeals of the Federal Circuit, Schering Corporation v. Geneva Pharmaceuticals, Inc. et al, Case Nos. 021540,-1541,-1542,-1543,-1544,-1545,-1546,-1547,-1548,-1549, 03-1021,-1022,-1023,-1025,-1027 (Fed. Cir. Aug. 1, 2003), the Court stated that "a prior art reference may anticipate without disclosing a feature of the claimed invention if that missing characteristic is necessarily present, or inherent, in the single anticipating reference," citing Continental Can Co. v. Monsanto Co., 948 F.2d 1264, 1268 (Fed. Cir. 1991). Even if Applicant were to concede that an array of pixel circuits *per se* is inherent in Wang, there is absolutely nothing in the device disclosed in Wang that would imply or suggest that an integrated array of pixel circuits is necessarily present or inherent within the same semiconductor substrate that embodies the array of pixels. In fact, the only signal-generating circuit described in Wang for use with the electro-optic beam steering device disclosed therein is an external signal generator 27.

On the contrary, the Examiner argues that "well known integrated circuits techniques could be used to conveniently provide the large plurality of signal generators" (emphasis added). Even the Examiner is admitting that a plurality of pixel circuits is not inherently formed within the semiconductor substrate of the Wang device, but only that such a plurality could be added thereto.

There is nothing in the Wang specification that suggests that a similar drive circuit could be conveniently integrated within the device itself, without the risk of the extra fabrication steps and processes, involving chemicals and elevated temperatures, causing adverse affects, e.g. related to device performance, reliability, etc.

Therefore, in light of the above-described lack of inherency, 35 U.S.C. 102(e) is not applicable. Arguably, Wang might be available against the present invention to show obviousness under 35 U.S.C. 103. However, even this would not be appropriate, due to the provisions of 35 U.S.C.103(c), since the invention of Wang and the present invention have a common assignee, Corning Applied Technologies, Corporation.

So, now that the Wang reference has been removed from consideration, the rejected claim 16 and the remaining rejected claims, all of which depend directly or indirectly from claim 16, should be in condition for allowance.

4. Conclusion

Based upon the above amendments, remarks, and papers of record, Applicant believes the pending claims of the above-captioned application are in allowable form and patentable over the prior art of record. Applicant respectfully requests reconsideration of the pending claims and a prompt Notice of Allowance thereon.

Applicant believes that no extension of time is necessary to make this Response timely. Should Applicant be in error, Applicant respectfully requests that the Office grant such time extension pursuant to 37 C.F.R. § 1.136(a) as necessary to make this Reply timely, and hereby authorizes the Office to charge any necessary fee or surcharge with respect to said time extension to the deposit account of the undersigned firm of attorneys, Deposit Account 03-3325.

Please direct any questions or comments to Ronald J. Paglierani at 607-974-3332.

AUGUST 22, 2003
Date

Respectfully submitted,
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CERTIFICATE OF MAILING
Under 37. C.F.R. § 1.8

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Ronald J. Paglierani 8/22/03
Ronald J. Paglierani Date